

Response Amendment

USSN 08/660,460

In this Office Action, the Examiner rejected independent claims 2 and 16 as follows:

Claims 2, ... 16... are rejected under 35 U.S.C. § 103 as being unpatentable over Crawford et al. "VIDEOMATIC SWITCHING: SYSTEMS AND SERVICES".

As per claim 2, Crawford teaches a teleconferencing system comprising:

a plurality of workstations having monitor, AV capture and reproduction capabilities

[fig.1]

a first network providing data path [p.39 col.1 last paragraph - "Data Switching"];

a second network providing AV path [p.39 col.1 - "Video/Audio Switch"]; and

managing the reproduction of video and audio [signaling] by utilizing the first network

[p.39 col.1 last paragraph - "data switching ... must accommodate ... application data and videotelephony signaling data."]

Crawford does not specifically disclose a data conference manager for managing a data conference and a AV conference manager for managing videoconference. It would have been obvious for one of ordinary skill in the art to have a data and AV manager in Crawford system because it would have enable integration of the data and AV for conferencing.

As per claim 16, it is rejected under similar rationales as for claim 2 above.

In addition, claims 5, 17 and 18 were rejected under 35 U.S.C. § 103 based on Crawford; claims 6-7 rejected under 35 U.S.C. § 103 as being unpatentable over Crawford in view of Goolcharan US patent 5,283,637; claims 8-9 and 19-20 under 35 U.S.C. § 103 as being unpatentable over Crawford in view of McFarland US patent 5,408,526; and claims 3-4 under 35 U.S.C. § 103 as being unpatentable over Crawford in view of Vin et al. "Multimedia Conferencing in the Etherphone Environment".

*Response Amendment*USSN 08/660,460

This amendment amends the independent claims and adds further claims in response to the Office Action and after the helpful teleconference with the Examiner.

The Issue

To establish *prima facie* obviousness of a claimed invention requires a showing by *convincing* reasoning that the prior art teaches or suggests all the claim elements. But, the primary reference (Crawford, et al.) relied on by the Examiner does not teach all the claim elements and is incompatible with the non-taught claim elements. Therefore, the issue is whether the non-teaching, incompatible Crawford reference can be shown by convincing reasoning to suggest all claimed elements? It is submitted that it cannot.

Crawford does not teach the claimed invention.

The Examiner has indicated that Crawford does not teach a data conference manager nor an AV conference manager. In addition, as discussed with the Examiner, Crawford does not teach data conferencing. Instead it teaches a file transfer protocol in an MS-DOS based environment. This file transfer protocol (FTP) is not able to support data conferencing and is used (as disclosed in Crawford) for e-mail, a non-data-conferencing application.

Crawford does not suggest all claim elements.

If it cannot be shown that the references *teach* all the claimed features, *prima facie* obviousness can only be establishing by showing that the prior art *suggests* the claimed

*Response Amendment*USSN 08/660,460

configuration.¹ This showing must be made by a convincing line of reasoning.² But, this cannot be done because Crawford does not contain the essential teaching or suggestion to make the claimed combination and the reasonable expectation of success.³

The Crawford system is an MS-DOS and FTP based system. This FTP-based system can simply not be used for data conferencing as required by the claims. It is technologically incompatible and there can, therefore, be no reason or suggestion why one could or would wish to include data conferencing with the Crawford reference.

Furthermore, Crawford does not teach an AV conference manager (admitted to be absent by the Examiner) that uses signalling on the data network to control the videoconference. The Examiner has indicated that the at least part of this feature has been suggested by Crawford in the first paragraph under § 6.2.3, page 39. But it is clear that this one sentence "teaching" is not enabling and is speculative at best. In fact, the very next sentence indicates that the complexities of such a system made it undesirable. This is a clear teaching away from the claimed invention.

¹ *In re: Royka*, 490 F.2d 981, 180 USPQ 580 CCPA 1974 as cited in the MPEP § 143.03.

² *Ex Parte Clapp* 227, USPQ, 972, 973 (Bd. Pat. App. & Inter. 1985) as cited in the MPEP § 2142.

³ *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991) as cited in the MPEP § 2142.

*Response Amendment*USSN 08/660,460

In this regard, the Examiner's is reminded that the claimed invention as a whole must be considered when making a determination of obviousness (MPEP §2141.02) and that the prior art references must be considered as a whole, including portions that would lead away from the claimed invention.⁴

It is strongly submitted that when these standards are applied to the claims, they are patentable. Nonetheless, in the interests of expediting allowance of these claims and after discussion with the Examiner, the Applicants have amended the claims to include a software layer at the workstation. This software layer communicates with the AV conference manager over the data network to enable the videoconference control. It is strenuously submitted that this feature is not obvious in the light of Crawford. By the Examiner's own characterization, Crawford does not include an AV conference manager. How then can Crawford have communication between the "conference manager" and the software layer to control the videoconference?

Applicants have also added new dependant claims. These, as with the other dependant claims are believed patentable as they depend on believed patentable independent claims.

In particular, the limitation to the communications between the AV conference manager and the software layer being established *before the videoconference is established* is not taught at


⁴ *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed.Cir. 1983), *cert denied*, 469 US. 851 (1984).

*Response Amendment*USSN 08/660,460

all by Crawford. In fact, Crawford teaches exactly the opposite — a POTS (audio) call is placed before any data signalling occurs. For the same reasons as before, therefore, it is submitted that this feature is patentable over the references.

For all the above reasons, Applicants request allowance of this application at the Examiner's earliest convenience. Should the Examiner believe a further conference will expedite the allowance of this application, contact with the undersigned is requested.

Respectfully submitted,



CRAIG P. OPPERMAN
Reg. No. 37,078

Cooley Godward
Five Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306-2155
Telephone: (415) 843-5000
Facsimile: (415) 857-0663